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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/690,515	10/23/2003	Shinichi Yamamura	00862.023328	6057
5514	7590	03/26/2008	EXAMINER	
FITZPATRICK CELLA HARPER & SCINTO 30 ROCKEFELLER PLAZA NEW YORK, NY 10112		QIN, YIXING		
		ART UNIT		PAPER NUMBER
		2625		
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/690,515	YAMAMURA, SHINICHI	
	Examiner	Art Unit	
	Yixing Qin	2625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 10 January 2008.
 2a) This action is **FINAL**. 2b) This action is non-final.
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-29 is/are pending in the application.
 4a) Of the above claim(s) 1-7,15-17,21-23 and 25-27 is/are withdrawn from consideration.
 5) Claim(s) _____ is/are allowed.
 6) Claim(s) 8-12,16-20,24 and 28 is/are rejected.
 7) Claim(s) _____ is/are objected to.
 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|----------------------------------------------------------------------------------------|-------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ . |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>8/27/04</u> . | 6) <input type="checkbox"/> Other: _____ . |

DETAILED ACTION

Election/Restrictions

Applicant's election without traverse of claims 8-12, 16-20, 24, and 28 in the reply filed on 1/10/08 is acknowledged.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

The claimed invention in claim 24 is directed to non-statutory subject matter.

Claim 24 is rejected under 35 U.S.C. 101 because they are directed towards an abstract idea. Under the current 101 guidelines (specifically, page 30 "Annex I"), there are three 101 judicial exceptions – law of nature, natural phenomenon, and abstract idea. A program is simply a set of instructions and does not produce a physical transformation or a tangible result. The suggested correction is to amend the claims to "A computer-readable medium encoding a program containing instructions for:"

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 8-10, 16-18, 24, 28 rejected under 35 U.S.C. 103(a) as being unpatentable over

Yamagishi (U.S. Patent No. 6,690,911)

Regarding claims 8, 16, 24, 28 Yamagishi discloses an information processing apparatus, which is connected to a printing apparatus, and controls the printing apparatus to print at least body text and tab data on print sheets including a tab print sheet, comprising:

a setup reception unit configured to receive a print setup; (column 7, lines 60-63 – tab mode)

a first command issuance unit configured to issue a first control command which instructs to execute a print process of the body text data in accordance with the received print setup; (column 1, lines 14-24 that tab sheets are used as inserts between jobs or as slip sheets. column 4 lines 26-33 discloses printing an image on an "ordinary" sheet P.)

Yamagishi further discloses a second command issuance unit configured to issue a second control command which instructs to execute a print process of a first face of the tab paper sheet in accordance with the received print setup; (column 4, lines 26-33 – an image is formed in tab sheet Pt)

Yamagishi does not explicitly disclose “a pause command issuance unit configured to issue a command that pauses a print process in the printing apparatus after the first and second control commands are issued;”

However, Yamagishi discloses in column 5, lines 46—column 6 line 42 discloses the reversal timing of a sheet of paper and how Yamagishi’s invention is improved to take into account certain error in the reversal time. While this is not explicitly a pause issuance, a certain pause has to occur due to the delay in the reversal of the sheet of tab paper.

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have included a pause unit to take into account the delay in the timing of the reversal of a sheet of paper.

The motivation would have been to wait until the paper is ready in order to print on the other side of the paper.

Therefore, it would have been obvious to alter Yamagishi to obtain the invention as specified.

Yamagishi further discloses a third command issuance unit configured to issue a third control command which instructs to execute a print process of a second face of the tab paper sheet in accordance with the received print setup. (column 4, lines 34-44 – a sheet is reversed and then an image is printed on the other side)

Regarding claims 9, 17, Yamagishi discloses the apparatus according to claim 8, wherein said setup reception unit comprises:

a paper source setup unit configured to receive designation of a paper source of the tab paper sheet; (column 7, lines 42-63 – tab mode is chosen and the controller 50 adjusts the image processing device to receive a tab sheet.)

a print style setup unit configured to receive designation of a print style on the tab paper sheet; (Fig. 9 - controller 50 facilitates all the various setups. One of them is item 56, where a tab size is inputted.)

an insertion position setup unit configured to receive an insertion position of the tab paper sheets among body text pages; (column 1, lines 14-24) and

an output setup unit configured to receive designation of an output unit that outputs a print result on the tab paper sheet. (Fig. 3 - item 4 - image writing device)

Regarding claims 10, 18, Yamagishi discloses the apparatus according to claim 9, wherein said setup reception unit further comprises:

a print style setup unit configured to receive designation of a print style of the body text data; (P[0013] discloses that the user can choose various options for printing including size, text, text type, etc) and

an output setup unit configured to receive designation of an output unit that outputs a print result of the body text data. (print engine 110 prints the result in Fig. 3)

II. Claims 11, 12, 19, 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yamagishi (U.S. Patent No. 6,690,911) in view of Rabb (4961092) and further in view of Wartinger (U.S. Patent No. 4,313,673)

Regarding claims 11, 19, Yamagishi discloses the apparatus according to claim 8, wherein when the tab paper sheet undergoes a print process while being inserted in the print sheets, on which the body text data is printed in a 2-sided print mode (column 4, lines 41-44), and

It does not explicitly disclose when “the number of body text pages before the tab paper sheet is odd, said first command issuance unit issues a blank page non-billing command that instructs to execute a non-billing blank page print process on a reverse face of the print sheet on which the body text data immediately before the tab paper sheet is printed.”

However, Rabb discloses in column 19, line 50 – column 20, line 42 discloses that chapterization is the automatically beginning of a chapter following a chapter end or tab insert sheet so that chapters start on the right side following an appropriate blank

left page. This is an indication that there was odd numbered pages of body text in the previous chapter and the “last page” is a blank insertion.

Additionally, the tertiary reference, Wartinger discloses in the abstract and column 2, lines 27-38 that automatically inserted blank pages are not billed.

All references are combinable because they are in the art of printing documents.

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have not charged for inserting a blank page.

The motivation would have been to allow documents to be better organized, such as in a case of printing chapters for a book.

Therefore, it would have been obvious to combine all references to obtain the invention as specified.

Regarding claims 12, 20, Yamagishi discloses the apparatus according to claim 8, wherein when the tab paper sheet undergoes a print process while being inserted in the print sheets, on which the body text data is printed in a 2-sided print mode, (column 4, lines 41-44)

and the number of body text pages before the tab paper sheet is odd, said first command issuance unit issues a 2-sided print command that instructs to print the body text data in a 2-sided print mode before execution of the print process of the body text data, and issues a 1-sided print command that instructs to print the body text data in a 1-sided print mode before execution of the print process of the body text data immediately before the tab paper sheet. (again, this is disclose by Rabb, where, for

example, pages in a chapter are two sided and then the last page of the chapter has only 1 printer side and an opposite blank side so that the first page of the next chapter starts on the right side. – while it is not explicitly disclosed which unit would perform this, one of ordinary skill knows that some module or function performs this task)

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yixing Qin whose telephone number is (571)272-7381. The examiner can normally be reached on M-F 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Moore can be reached on (571) 272-7437. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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YQ

/David K Moore/
Supervisory Patent Examiner, Art Unit 2625